THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEFAN ETTER, BEAT STULZ, THOMAS NIETLISPACH,
CHRISTIAN GILLIERON and CHRISTIAN MOY

Appeal No. 1999-0709
Application No. 08/400,335

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 15-23. Claims 1-14 and 24-86, the only other claims pending in this application, stand withdrawn from further consideration under 37 CFR § 1.142(b) as being directed to a non-elected invention.

BACKGROUND

The appellants' invention relates to a tamper-resistant postage meter. An understanding of the invention can be derived from a reading of exemplary claim 15, which appears in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hubbard	4,246,643	Jan. 20, 1981
Miller et al. (Miller)	4,864,505	Sep. 5, 1989

The following rejection is before us for review.

Claims 15-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hubbard in view of Miller.

Reference is made to the brief (Paper No. 13) and the answer (Paper No. 14) for the respective positions of the appellants and the examiner with regard to the merits of this rejection.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. For the reasons which follow, we cannot sustain the examiner's rejection.

Hubbard, the primary reference relied upon by the examiner, discloses a postal meter comprising postage printing wheels 166 (Figure 5) having a plurality of raised heads for the numerals 0-9 formed on the outer circumference thereof, with the bottom circumferential regions thereof forming a printing face 186 which faces a letter receiving slot 20, and postage setting wheels 164 for adjusting the angular positions of the postage printing wheels. The position of each of the setting wheels, and thus the postage setting, is monitored by means of an adjacent encoder disc, such as disc 176. The printing wheels are carried by a print system support 32. An inking roller 74 is also connected to the print system support via a linkage comprising a first arm 76 and a second arm 82, a web 84 and a shield 62, 64, 66. The printing cycle is commenced by depressing a cover member 38, thereby forcing a roller 88 downward, which causes the second arm 82 to pivot in a counterclockwise direction from the position shown in Figure 8 to that shown in Figure 9 to draw the first arm 76 and inking roller 74 across the printing face. The depression of the cover member 38 also actuates a switch 98 to cause it to generate an "inking complete" signal for use by a microcomputer module 26 contained in the meter. Upon receipt of an "inking complete" signal, the microcomputer reads and decodes the encoding disc associated with each of the postage printing wheels. A descending register keeps an accounting of the remaining postage balance. If the postage balance is not sufficient to print the requested postage amount, the microcomputer will energize an indicator to notify the user of that fact. Under these conditions, the user will be unable to

force the print system support 32 past the position shown in Figure 9 in which a release lever 44 pivotally attached thereto and biased to the left by a spring 50 contacts the upper surface of a detent block 28. If, on the other hand, the postage balance is sufficient, and if a letter is detected in the letter receiving slot 20, the microcomputer generates a control signal to energize a solenoid 42 to draw the release lever 44 to the right against the force of the spring 50, so that the release lever 44 clears the detent block 28, as shown in Figure 10. Under these circumstances, continued downward pressure on the cover member 38 forces the printing wheels into the letter receiving slot to print postage on the face of the letter in that slot (column 7, lines 37-65).

The examiner concedes that Hubbard lacks "a rotor rotatable relative to the main body for imprinting postage indicia on a mail piece through rotation thereof" as required by each of the appellants' independent claims 15, 22 and 23. However, the examiner contends that

> [i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the postage meter of Hubbard with the rotating print drum and necessary supporting structure as taught by Miller so as to enhance the printing efficiency of the postage meter. The mere application of one type of print drum over another based upon their well known properties and intended use by those having ordinary skill in the art would involve no unobviousness [answer, page 4].

The test of obviousness is "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). However, obviousness "cannot be established by combining the

teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellants' disclosure. See, e.g., Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

While we appreciate that Miller discloses a postage meter comprising a rotatable print drum 126 for imprinting postage on an envelope 16 through rotation thereof and that Hubbard and Miller teach that linearly moving and rotary print heads are both well known print systems for use in postage meters, it is not apparent to us why one of ordinary skill in the art would have been led by the combined teachings of these references to make the modification proposed by the examiner. Specifically, the mounting of the depressible cover member 38 relative to the print system support 32, the "inking complete" switch 98, the release lever 44, the solenoid 42 and the detent block 28 of Hubbard are particularly designed to cooperate in the context of a linearly actuated and linearly moving printing face. Thus, we are at a loss to understand why or, for that matter, how, one of ordinary skill in the art would have replaced the linearly moving arrangement of Hubbard with a rotary arrangement of the type taught by Miller while still maintaining all of the necessary cooperation between the above-noted elements of Hubbard.

Accordingly, we shall not sustain the examiner's rejection of independent claims 15, 22 and 23, or claims 16-21 which depend from claim 15.

CONCLUSION

To summarize, the decision of the examiner to reject claims 15-23 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT Administrative Patent Judge	)
JEFFREY V. NASE Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)

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